

REMARKS

Claims 15-17 and 23-27 are pending in this application. By this Amendment, claim 15 is amended. Claims 23-27 are added. The amendments and the added claims introduce no new matter. Claims 18-22 are canceled without prejudice to, or disclaimer of, the subject matter recited in those claims. Reconsideration of the application based on the above amendments and the following remarks is respectfully requested.

Applicants appreciate the courtesies shown to Applicants' representative by Examiner Nicholson in the April 12 personal interview, and moreover by Examiner Crawford in the April 12 telephone interview. Applicants' separate record of the substance of the interviews is incorporated into the following remarks.

The Office Action, in paragraph 3, rejects claims 15-22 under 35 U.S.C. §102(b) as being anticipated by the article "Bridging Physical and Virtual Worlds with Electronic Tags" by Want et al. (hereinafter "the Want article"). The Office Action, in paragraph 4, rejects claims 15-17 and 22 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,551,681 to Ferrara. These rejections are respectfully traversed.

The Want article teaches a variety of scenarios implemented using a novel combination of inexpensive, unobtrusive and easy to use RFID tags, tag readers, portable computers and wireless networking (page 370). Specifically, when referring to certain sample applications and prototypes, the Want article indicates that tags can be located upon or within a document binder as shown in Fig. 3, can be embedded within other marks such as an embossing seal as shown in Fig. 4 or can even be located in or on the document staple (page 373). The differing structures shown in the Want article do not, however, provide any detail by which such location and attachment of any RFID tag takes place.

In response to Applicants previously having made arguments traversing rejections based on the Want article, this Office Action, in the Response to Arguments section

(paragraph 1 on page 2), states that "though Want does not explicitly disclose the features, it is inherent that a storage medium is attached to the image forming member using a staple needle." Based on Applicants confusion regarding how the Office Action could assert that such a feature necessarily flows from the disclosure of Want, in accordance with the standards for a showing of inherency, Applicants' representative sought clarification from Examiner Nicholson during the April 12 personal interview. The Examiner, without clarification, simply maintained his position that features not explicitly disclosed in the Want article were somehow inherent based on the teachings of the Want article.

Seeking further clarification, Applicant's representative contacted Examiner Crawford. Examiner Crawford was able to provide some clarification regarding the Patent Office's interpretation of what the Want article could reasonably be considered to at least have suggested with regard to the subject matter of the pending claims. Applicants do not concede the interpretation of the Want article, as set forth in this Office Action, and as previously set forth throughout prosecution of this application. Rather, and in an effort simply to advance prosecution, Applicants voluntarily amend claim 15 to clarify the features recited therein, and to attempt to better distinguish the positively recited claim features over any even broad construction of what the Want article can reasonably be considered to teach, or to have suggested, with respect to the subject matter of the pending claims.

Ferrara teaches a disk compiler integrated into a disk stacker or disk-in-disk finisher in which printed sheets are sequentially individually fed into a first sheet retaining unit, which rotates to move the sheet into a second sheet retaining unit neatly compiling a plurality of sheets therein in an arcuate configuration as a complied set (Abstract). The second sheet retaining unit of Ferrara then rotates to eject the compiled set of plural sheets, and a stapling system may be provided for stapling the complied sets while they are so held in the second sheet retaining unit (Abstract). The Office Action broadly construes Ferrara, and the mere

mention of a stapling system, to indicate that Ferrara may reasonably be considered to teach a method for postprocessing that may correspond to the subject matter of at least independent claim 15. Applicants believe that it requires an overly broad construction of the disclosure of Ferrara to assert that "a blank sheet of paper can be considered a storage medium since information may be printed or attached thereto," as stated in the Office Action, attempting to justify the application of Ferrara to the subject matter of the pending claims.

Applicants do not believe that the Federal Circuit's standard for anticipation is met with respect to claim 15 in that "[t]o anticipate, every element and limitation of the claimed invention must be found in a single prior art reference, arranged as in the claim" (emphasis added, citations omitted). Applicants do not believe that either of the above references clearly and unequivocally discloses the claimed invention in a manner by which all of the elements are found in a single reference "in exactly the same situation and united the same way to perform the identical function," as is recited in the pending claims (*see Sandisk Corp. v. Lexar Media, Inc.* 91, F. Supp. 2d 1327, 1336 (N.D. Calif. 2000)). Again here, however, Applicants voluntarily amend claim 15 to clarify the subject matter recited therein, and to attempt to better distinguish the features recited in that claim over an even broad interpretation of Ferrara.

Claim 15 recites a method for performing a postprocessing with respect to an image forming member on which an image is to be formed, the method comprising: receiving image data and instruction for attaching a storage medium; forming an image on an image forming member based on the received image data; stapling a staple needle, to which a storage medium is attached, to the image forming member on which image formation has been started; and writing the received image data into the storage medium.

Neither the Want article nor Ferrara can reasonably be considered to teach, or to have suggested such a combination of features as are positively recited in the method of claim 15.

Further, claims 16 and 17 are also neither taught, nor would they have been suggested, by these references for at least the respective dependence of these claims on an allowable base claim, as well as for the separately patentable subject matter that each of these claims recites.

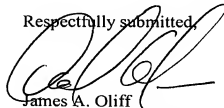
Accordingly, reconsideration and withdrawal of the rejections of claim 15-17 under 35 U.S.C. §102(b) as being anticipated by the Want article or by Ferrara are respectfully requested.

Independent claims 23 and 24 recite similar features that are neither taught, nor would they have been suggested, by the applied references, and claims 25-27 depend from allowable base claims. As such, claims 23-27 are also allowable over the applied references.

In view of the foregoing, Applicants respectfully submit that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 15-17 and 23-27 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact Applicants' undersigned representative at the telephone number set forth below.

Respectfully submitted,



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